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10/713,939

11/13/2003

Samuel Zellner

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EXAMINER

SHEDRICK, CHARLES TERRELL

ART UNIT

PAPER NUMBER

2617

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/713,939 | Applicant(s) ZELLNER, SAMUEL | |
| | Examiner CHARLES SHEDRICK | Art Unit 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/9/08 have been fully considered but they are not persuasive.
2. Applicant argues that neither Mun nor Hwang discloses or suggests selection of all enhanced originator information based upon the service plan and the terminal capability of the recipient terminal as set forth in Applicant's claims 1, 8, and 15 as amended.
3. The Examiner respectfully disagree with the Applicant's assertion that Mun does not disclose the claimed element "selecting all information elements associated with the originator terminal by retrieving the information elements from a network database based upon the service plan and the terminal capability of the recipient terminal". Carefully note that "all" would read on one element if the one element is "all" that's available. Consider that Mun teaches using images as caller id as noted in at least the abstract. Accordingly, if Mun is providing "all" information elements associated with the terminal (e.g., image and text) then it reads on the claim even if "all" of the elements is limited to a qty. of one.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2,4-6,8-9, 11-19, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mun et al. US Patent Pub. No. 2003/0022659 A1, hereinafter, "Mun" in view of Hwang US Patent. Pub. No.: 2003/0092432

Consider **claims 1,8 and 15**, Mun teaches a Method, A storage medium including machine readable computer program code, and a System for transmitting enhanced originator information over a communication network (**i.e., see at least abstract regarding Caller ID information**) comprising: retrieving a service profile for a recipient terminal from a service profile database (**i.e., HLR, VLR, or storage system within the MSC**) in response to initiation of a communication by an originator terminal to the recipient terminal (**i.e., see at least paragraphs 0031-0033, figure 5 and claim 10**);the service profile retrieved using a recipient terminal address in the communication initiation(**i.e., see at least paragraphs 0031-0033, figure 5 and claim 10**), the service profile specifying a service plan and terminal capability of the recipient terminal and terminal capability of the recipient terminal to retrieve the enhanced originator information from the originator terminal(**i.e., see at least paragraphs 0031-0033, figure 5 and claim 10**); processing the service profile to determine types of information elements that the recipient terminal receives to make an enhanced originator identification of the

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originator terminal(**i.e., see at least paragraphs 0031-0033, figure 5 and claim 10**); selecting all information elements by retrieving all information elements from a network database by retrieving information elements associated with the originator terminal from a network database (**i.e., see at least paragraphs 0034-0035 and figures 6 and 7**), the retrieving based upon at least one of the service plan and terminal capability of the recipient terminal (**i.e., see at least paragraphs 0031-0035 and figures 6 and 7**);and transmitting a communication including said information elements to the recipient terminal prior to establishing a communication session with the recipient terminal (**i.e., see at least figures 5-8 and claims 1,8, and 16**) wherein the transmitting is conducted over at least one of : an IP network, a PSTN, peer to peer, a WLAN, a wireless network, a cable network a fiber optic network, a video network, and a satellite network(**i.e., see at least figures 5-8 and claims 1,8, and 16**)

However, Mun does not specifically disclose wherein the information elements include advertising material.

In analogous art, Hwang teaches information elements from a network database wherein the information elements include advertising material (**e.g., see paragraph 0029, figures and abstract**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Mun to include wherein the information elements include advertising material for the purpose of proving caller id including an advertisement.

Consider **claims 2, 9 and 16 and as applied to claims 1, 8, and 15 above**, Mun as modified by Hwang teaches wherein the terminal capability relates to at least one of a: terminal device type including at least one of: a personal computer, a network computer, a wireless

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mobile telephone, a wireless mobile computer device, a facsimile, a network appliance, and a wire-line telephone, and terminal device technology features including at least one of: binary-based caller-identification feature; and graphical features (**i.e., see at least abstract and paragraph 0008**).

Consider **claims 4, 11, and 18 and as applied to claims 1, 8, and 15 above**, Mun as modified by Hwang teaches wherein the communication comprises at least one of: Voice; Data; Video; Messaging; Instant Messaging; and Paging (**i.e., see at least abstract and paragraph 0008**).

Consider **claims 5 and 12 and as applied to claims 1 and 8 above**, Mun as modified by Hwang teaches wherein the communication including the elements are generated by said communications network (**i.e., see at least abstract and paragraph 0008**).

Consider **claims 6, 13, and 19 and as applied to claims 1, 8, and 15 above**, Mun as modified by Hwang teaches wherein the communication network includes at least one of: a circuit-switched network; a packet-switched network; a wireless network; an asynchronous transfer mode network; and a Multi-protocol Label Switching (MPLS) network(**i.e., see at least paragraph 0008**).

Consider **claims 7 and 14 and as applied to claims 1 and 8 above**, Mun as modified by Hwang teaches wherein the service plans (*i.e.*, subscriber data) are stored in a service profile database (**i.e., see at least paragraphs 0034-0035 and figures 6 and 7**), the plans stored in a dual format operable for accommodating both graphically-enabled caller identification devices and caller identification devices that are not graphically enabled (**i.e., see at least paragraphs 0031-0035 and figures 6 and 7**).

Consider claims 21, 22, and 23 and as applied to claims 1, 8, and 15 above, Mun as modified by Hwang teaches wherein the service plan includes controlling the presentation of the communication of the recipient terminal by screening the information elements in the communication based upon at least one of the content and format of the information elements (i.e., users register PCID registration mode beforehand and can use still image, characters, or moving pictures)(i.e., see at least paragraph 0024,0028-0029), the screening performed based upon criteria configured by a user of the recipient terminal (i.e., users register PCID registration mode beforehand and can use still image, characters, or moving pictures)(i.e., see at least paragraph 0024,0028-0029) .

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES SHEDRICK whose telephone number is (571)272-8621. The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harper Paul can be reached on (571)-272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/
Supervisory Patent Examiner, Art Unit 2617

/Charles Shedrick/
Examiner, Art Unit 2617
July 18, 2008